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10/606,786	06/27/2003	Sandrine Decoster	238017US0	6389
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER ARNOLD, ERNST V	
			ART UNIT	PAPER NUMBER
			1616	
			NOTIFICATION DATE	DELIVERY MODE
			03/06/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/606,786

Applicant(s)

DECOSTER ET AL.

Examiner

ERNST V. ARNOLD

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 44-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43, 47 and 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/08/08 has been entered.

Claims 1-48 are pending. Claims 44-46 have been withdrawn as being directed to non-elected subject matter in the response filed with traverse on 7/19/08. Claims 1-43, 47 and 48 are under examination as they read on the elected subject matter which was Quaternium 80 as the silicone polymer and isostearyl alcohol as the fatty alcohol.

Withdrawn rejections:

Applicant's amendments and arguments filed 12/8/08 are acknowledged and have been fully considered. Any rejection and/or objection not specifically addressed below is herein withdrawn. Applicant has defined the conditions for which the fatty alcohol is a liquid and the reference of Janchitraponvej et al. (US 5,556,615) no longer anticipates this limitation and the rejection is withdrawn as well as the 35 USC 103(a) rejection with Janchitraponvej et al. (US 5,556,615) as the primary reference is also withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-43, 47 and 48 remain/are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchiyama et al. (US 5876705) in view of Jacquet et al. (US 4,390,522), Dupuis (US 6,214,326) and Vatter et al. (US 6,224,888).

Applicant claims a transparent composition comprising, in a cosmetically acceptable medium, at least one silicone with quaternary ammonium groups and at least one fatty alcohol which is liquid at 25°C and at 1 atm.

Determination of the scope and content of the prior art

(MPEP 2141.01)

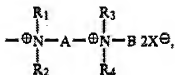
Uchiyama et al. teach conditioning shampoo compositions and methods of cleaning and conditioning hair (Abstract and claims 1-30). Uchiyama et al. teach a composition with from about 5% to about 50% by weight of a surfactant, including anionic, nonionic and cationic surfactants, from about 0.9% to about 10% by weight of a fatty alcohol such as isostearyl alcohol and from about 0.05% to about 20% by weight of a water soluble cationic polymeric conditioning agent (Claims 1-3). Fatty alcohols are described in detail in column 10, line 15 through column 11, line 53). The water soluble cationic polymeric conditioning agents produce substantially clear solutions which would read on transparent (column 17, lines 8-15). Suitable water soluble cationic polymeric conditioning agents include a wide variety of materials including cationic ammonium salts of the structure, for example,



(column 17, lines 8 through column 19, line 27). Suitable cationic surfactants include quaternium 80 as well as quaternium 83, which is the compound of formula (VI) in claim 15, and mixtures thereof (column 20, lines 21-23). Cationic silicones are used as hair conditioning agents (column 12, line 41 through column 15, line 13). Clearly, the concept of hair compositions with fatty alcohols and more than one cationic compound is taught in the art by Uchiyama. Uchiyama et al. teach composition in water which would intrinsically be solutions, suspension or dispersion (column 24, lines 40-60 and claim 1). Uchiyama et al. teach adding a polyalkylene glycol as a cosmetically acceptable solvent (claim 1). Uchiyama et al. teach suspending agents thickeners, viscosity modifiers, and gelling agents, (column 21, line 47 through column 22, line 55) as well as adding other agents such as preservatives, electrolytes, pH

adjusting agents, fragrances, moisturizers, humectants, antiinflammatory agents and antidandruff agents (column 22, line 56 through column 23, line 23). The composition is intrinsically a rinse-out after-shampoo.

Jacquet et al. teach the addition of 0-25 weight percent of a fatty alcohol such as oleyl, lauryl, myristyl, cetyl, stearyl, and isostearyl alcohols to diquaternary ammonium cationic polymer cosmetic compositions for application to the hair (Claims 1, 11 and 12). Shown below is the diquaternary ammonium cationic polymer, which can be present from 0.1% to 5% in shampoos (Column 8, lines 45-48).



Jacquet et al. teach emulsifiers such as oleyl alcohol polyoxyethylenated with 10 to 30 moles of ethylene oxide, for example (Column 7, lines 15-42). Jacquet et al. teach fatty alcohols of 9-15 carbons polyoxyethylenated with 5 to 10 moles of ethylene oxide (column 7, lines 29-31). Jacquet et al. teach nonionic detergents such as ethers of polyethoxylated fatty alcohols (Column 7, lines 65-67). Jacquet et al. teach the further addition of cosmetic resins such as polyvinylpyrrolidone and copolymers of polyvinylpyrrolidone (Column 8, lines 54-61). Jacquet et al. teach cationic detergents such as long-chain quaternary ammoniums, alkylpyridinium salts, polyether fatty amines, or imidazoline derivatives (Column 7, lines 62-64). Jacquet et al. teach lauryltrimethylammonium chloride as a cationic ammonium compound which renders obvious other alkyltrimethylammonium salts present in the composition from about 5% to about 10% by weight of the composition in total (Column 12, lines 23-25 and 49). Jacquet et al. teach the

addition of perfumes, dyes, thickening agents, foam stabilizing agents and softening agents (Column 8, lines 40-44).

Dupuis teaches cosmetic compositions for treating keratinous material containing cationic polymers and acrylic terpolymers (Abstract). Dupuis teaches that the thickening and/or gelling polymers combined with cationic polymers produces cosmetic formulations which are not pasty or greasy and which give hair good properties of softness, feel and easy disentangling (Column 1, lines 36-44). The thickening and/or gelling polymers are terpolymers with a) methacrylic acid or acrylic acid; b) methacrylates, acrylates such as methyl, ethyl and butyl acrylate, and nonionic surfactants, and c) nonionic urethane monomer (Column 1, line 59 bridging Column 2, lines 63). Dupuis teaches cationic polymers of silicone, polyamines, polyaminoamides and quaternary polyammonium types as known products (Column 3, lines 52-55). Dupuis teaches quaternized vinyl pyrrolidone dialkylaminoalkyl acrylate or methacrylate copolymers, cellulose derivatives containing quaternary ammonium groups, dimethyldiallylammonium salts of hydroxypropylcellulose, cationic polysaccharides and in particular guar gums, polymers consisting of piperazinyl units, water soluble polyaminoamides, methylallylamine or dimethyldiallyl-ammonium cyclopolymers, polyquaternary ammonium polymers of formula VIII found in column 10, lines 25-30, homopolymers or copolymers derived from acrylic or methacrylic acid, quaternary vinylpyrrolidone and vinyl-imidazole polymers, polyamines, methacryloyloxyethyltrimethylammonium chloride crosslinked polymers, condensates of polyamines and epichlorohydrin, and chitin derivatives, for example (Column 3, line 56 through column 12, line 20 and claims 1 and 11). Dupuis teaches that when the composition is a leave-in type it comprises one or more of quaternized or non-quaternized

vinylpyrrolidone/dialkylaminoalkyl acrylate or methacrylate copolymers or quaternary vinylpyrrolidone or vinylimidazole polymers (Claim 12). Dupuis teaches the composition as a rinse-out or leave in hair product (Claim 18).

Vatter et al. teach conventional thickening agents including synthetic polymeric materials such as polyvinylpyrrolidone for use in cosmetic compositions (Column 9, line 60 bridging column 10, line 19).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

1. Uchiyama et al. do not expressly teach a composition with the instantly elected species that is transparent.

2. Uchiyama et al. do not expressly teach a composition with the cationic polymers of instant claims 21-27. This deficiency in Uchiyama et al. is cured by the teachings of Dupuis and Jacquet et al.

3. Uchiyama et al. et al. do not expressly teach a composition wherein the thickening agent is selected from a member of instant claim 32 or a crosslinked homopolymer of vinylpyrrolidone. This deficiency in Uchiyama et al. is cured by the teachings of Vatter et al., Dupuis and Jacquet et al.

Finding of prima facie obviousness

Rational and Motivation (MPEP 2142-2143)

1. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made the composition of Uchiyama et al. transparent and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because: Uchiyama et al. teach substantially clear compositions as described above. Furthermore, since the same ingredients are used as instantly claimed then the composition is intrinsically transparent.

2. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to add the quaternary amine cationic polymers of Jacquet et al. or Dupuis to the composition of Uchiyama et al. and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because: "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). It is the Examiner's position that the polymer renders obvious the quaternary monomer.

3. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to add between 0.001% and 20% thickening agents taught by Dupuis, Jacquet et al. and suggested by Vatter et al. in the composition of Uchiyama et al. and produce the instant invention.

One of ordinary skill in the art would have been motivated to do this because Uchiyama et al. suggest adding thickening agents and Dupuis teaches that the thickening and/or gelling

polymers combined with cationic polymers produces cosmetic formulations which are not pasty or greasy and which give hair good properties of softness, feel and easy disentangling (Column 1, lines 36-44). Vatter et al. teach that polyvinylpyrrolidone is a conventional thickening agent and it is the Examiner's position that one of ordinary skill in the art would immediately recognize polyvinylpyrrolidone as a thickening agent and one of ordinary skill in the art has the ability to crosslink a homopolymer of polyvinylpyrrolidone. The amount of thickening agent is merely a matter of routine optimization. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient needed to achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, the optimization of ingredient amounts would have been obvious at the time of applicant's invention.

Summary:

All the components claimed are known in the art for use in the same purpose. Each element acts in an expected manner. Quaternium 80 acts as quaternium 80 and isostearyl alcohol acts as isostearyl alcohol. All Applicant has done is assemble known elements in the art into one composition. **This is relevant to commercial success not invention.** (See *ANDERSON'S-BLACK ROCK, INC., Petitioner, v. PAVEMENT SALVAGE CO.*, U.S.P.Q. 673, 396 U.S. 57, 90 S.Ct. 305, 24 L.Ed.2d 258, 163). Applicant has not argued synergy.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill in the art might reasonably infer from the teachings. (*In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA) 1976).

In light of the forgoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Response to arguments:

Applicant's arguments are moot in view of the new ground of rejection.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernst V. Arnold whose telephone number is 571-272-8509. The examiner can normally be reached on M-F (7:15 am-4:45 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Ernst V Arnold/
Examiner, Art Unit 1616